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EXAMINER
KEEFER, MICHAEL E

ART UNIT	PAPER NUMBER
2454	

NOTIFICATION DATE	DELIVERY MODE
11/21/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2008*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is responsive to the Amendment and RCE filed 9/15/2008.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3.   Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the newly amended part of claims 1 and 7 "wherein, when the peripheral device is connected to the personal computer an embedded web server in the peripheral device configured to serve web pages is used without user interaction to access the URL containing the driver software to automatically download the driver software to the personal computer and automatically launch and install the downloaded driver software on the personal computer...". The specification does not support the peripheral device having a web server that accesses a URL, downloads software, and then installs it on a personal computer. The closest mention the examiner can find to this is original claim 11 - however, original claim 11 merely states that the peripheral -has- a web server, and refers to a 'step of accessing' which is not found in originally filed claim 7. The

specification itself is silent about the peripheral having a web server, much less the web

server doing any accessing, downloading and installing.

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

5.   Claim 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Regarding claims 1 and 7, the term 'web server' is used contrary to its accepted

meaning in the phrase 'an embedded web server ... is used without user

interaction to access the URL'. Web servers serve web pages, they do not

access URLs. The Examiner suggests clarification of this clause to indicate what

exactly is occurring at the Web server, because after reviewing Applicant's

specification, the Examiner is interpreting this clause for the purposes of the

application of prior art to mean that the web browser passes the URL to the

personal computer so the personal computer's web browser can then access the

website and perform the rest of the method as described in the claims.

Claim Rejections - 35 USC § 103

6.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

7.   Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Cantwell (US 2002/0147795) in view of Minolta (JP2001117835 A, Derwent

abstract, PAJ Translation also provided), further in view of Williams et al. (US

2002/0129353), hereafter Williams and further in view of Hui (US 2003/0220983).

Regarding **claim 1**, Cantwell discloses:

A system comprising:

a personal computer comprising a web browser that provides communication

between the personal computer and the Internet; and (Fig. 1, Computer 4)

a peripheral device coupled to the personal computer, that comprises a

device driver 25, and (Fig. 1, 8, 10, 12, are all peripheral devices)

a uniform resource locator (URL) that identifies and is used to direct the web

browser to a location on the Internet where appropriate driver software is located

and available for downloading and installation on the personal computer; ([0015]

discloses a URL to a driver website)

and wherein, when the peripheral device is connected to the personal

computer, the URL launches a browser on the personal computer which is directed

to the Internet location containing the driver software, automatically downloads the

driver software to the personal computer, and automatically launches and installs the

downloaded driver software on the personal computer without user interaction.

([0015] (following a URL to the driver website), [0019] "At the website the browser

downloads and executes executable code. ... The executable code installs any

required software to the client.", [0020] The information about the device ... may be

passed from the browser to the executable code.", [0022] automatically selecting a driver, [0023] automatically downloading and installing/configuring the driver.)

an embedded web server in the peripheral device capable of serving its own web pages. ([0015] discloses the device hosting its own website having the URL within it.)

Cantwell discloses all the limitations of claims 1-3 and 6 except for the URL being stored in the firmware of the peripheral.

The general concept of storing a URL to a device driver in the firmware of a peripheral device is well known in the art as taught by Minolta. ("The flash ROM stores the URL of driver software that is required to control printer.", see Derwent Abstract)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Cantwell with the general concept of storing a URL to a device driver in the firmware of a peripheral device as taught by Minolta in order to stop users from having to search for an appropriate URL to find device drivers since it is resident in the peripheral device itself.

Cantwell and Minolta teach all the limitations of claims 1-3 and 6 except for having information about the device being part of the URL.

The general concept of including device model information in a URL for gaining device drivers is well known in the art as taught by Williams. (see [0044]-[0045] which teach using a filename to identify the type of device the driver is for, the file name being inherently part of a url to retrieve said driver.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cantwell and Minolta with the general concept of including device model information in a URL for gaining device drivers as taught by Williams in order to make the system more efficient.

Cantwell, Minolta and Williams teach all the limitations of claims 1-3 and 6 except for periodically checking the url for updates.

The general concept of checking a URL for driver updates on a periodic basis is well known in the art as taught by Hui. (See [0005] which teaches periodically checking a URL for updates)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cantwell, Minolta and Williams with the general concept of checking a URL for driver updates on a periodic basis as taught by Hui in order to make sure that drivers are up to date.

Regarding **claim 2 as applied to claim 1**, see Fig. 1, printer 8.

Regarding **claim 3 as applied to claim 1**, see Fig. 1, scanner 10.

Regarding **claim 6 as applied to claim 1**, see Fig. 1, intranet connection 14.

8.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cantwell, Minolta, Williams, and Hui as applied to claim 1 above, and further in view of Anderson et al. (US 7222357), hereafter Anderson.

Cantwell, Minolta, Williams, and Hui teach all the limitations of claim 4 except that the peripheral is a camera.

Anderson teaches cameras attached to a network, see Fig. 7.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cantwell and Minolta with the camera network of Anderson in order to allow users to easily download drivers for a camera they connect to via the internet.

9.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cantwell, Minolta, Williams, and Hui as applied to claim 1 above, and further in view of Koss (US 2002/0112037).

Cantwell, Minolta, Williams, and Hui teach all the limitations of claim 5 except that the peripheral is a plotter.

The general concept of having a plotter on a network is well known in the art as taught by Koss. [0004]

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cantwell and Minolta with the general concept of having a plotter on a network as taught by Koss in order to allow plotters to also to distribute their drivers as do printers.

10.   Claims 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cantwell in view of Minolta in view of Williams, in view of Hui, and in further view of Shaefer (US 2001/0053977).

Regarding **claim 7**, Cantwell discloses:

A method for use with a system comprising a peripheral device and a personal computer having a browser that provides communication, the method comprising the steps of:

a uniform resource locator (URL) to an Internet location where appropriate device drivers for the peripheral device are made available for downloading; ([0015] discloses a URL to a driver website)

using the URL and the web browser to automatically connect the personal computer to the Internet location holding the device drivers; ([0015] discloses a URL to a driver website)

automatically connecting the personal computer to the Internet location holding the device drivers using the URL and the web browser; downloading a driver installation package containing a device driver for the peripheral device from the Internet site to the personal computer using the web browser that is appropriate to the personal computer and its operating system and that is capable of implementing a driver installation process without the user specifying any option selections; and automatically initiating the driver installation process upon receipt of the driver installation package to install the device driver for the peripheral device on the personal computer. ([0015] (following a URL to the driver website), [0019] "At the website the browser downloads and executes executable code. ... The executable code installs any required software to the client.", [0020] The information about the device ... may be passed from the browser to the executable code.", [0022] automatically selecting a driver, [0023] automatically downloading and installing/configuring the driver.)

Cantwell discloses all the limitations of claims 7-13 except for the URL being stored in the firmware of the peripheral.

The general concept of storing a URL to a device driver in the firmware of a peripheral device is well known in the art as taught by Minolta. ("The flash ROM stores the URL of driver software that is required to control printer.", see Derwent Abstract)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Cantwell with the general concept of storing a URL to a device driver in the firmware of a peripheral device as taught by Minolta in order to stop users from having to search for an appropriate URL to find device drivers since it is resident in the peripheral device itself.

Cantwell and Minolta teach all the limitations of claims 7-13 except for having information about the device being part of the URL.

The general concept of including device model information in a URL for gaining device drivers is well known in the art as taught by Williams. (see [0044]-[0045] which teach using a filename to identify the type of device the driver is for, the file name being inherently part of a url to retrieve said driver.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cantwell and Minolta with the general concept of including device model information in a URL for gaining device drivers as taught by Williams in order to make the system more efficient.

Cantwell, Minolta and Williams teach all the limitations of claims 7-13 except for periodically checking the url for updates.

The general concept of checking a URL for driver updates on a periodic basis is well known in the art as taught by Hui. (See [0005] which teaches periodically checking a URL for updates)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cantwell, Minolta and Williams with the general concept of checking a URL for driver updates on a periodic basis as taught by Hui in order to make sure that drivers are up to date.

Cantwell, Minolta, Williams, and Hui teach all the limitations of claims 7-13 except for communicating information regarding the personal computer and its operating system to the Internet location using the web browser.

The general concept of using network headers to determine information regarding a personal computer and its operating system is well known in the art as taught by Shaefer. ([0016])

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cantwell, Minolta, Williams and Hui with the general concept of using network headers to determine information regarding a personal computer and its operating system as taught by Shaefer in order to eliminate user mistakes in identifying characteristics of the user's computer.

Regarding **claims 8-9 as applied to claim 7**, Cantwell discloses:

It is an inherent property of an installation process for drivers to notify a user that the installation is complete.

Regarding **claim 10 as applied to claim 7**, Cantwell discloses:

The step of accessing the URL comprises the step of using low-level commands. ([0017] discloses directly browsing to the website.)

Regarding **claim 11 as applied to claim 7**, Cantwell discloses:

The step of accessing the URL comprises the step of providing high level access via an embedded web server in the peripheral device capable of serving its own web pages. ([0015] discloses the device hosting its own website having the URL within it.)

Regarding **claim 12 as applied to claim 7**, see Fig. 1, printer 8.

Regarding **claim 13 as applied to claim 7**, see Fig. 1, scanner 10.

11.   Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cantwell, Minolta, Williams, Hui, and Shaefer as applied to claim 7 above, and further in view of Anderson et al. (US 7222357), hereafter Anderson.

Cantwell, Minolta, Williams, Hui, and Shaefer teach all the limitations of claim 4 except that the peripheral is a camera.

Anderson teaches cameras attached to a network, see Fig. 7.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cantwell, Minolta, Williams, Hui, and Shaefer with the camera network of Anderson in order to allow users to easily download drivers for a camera they connect to via the internet.

12.   Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cantwell, Minolta, Williams, Hui, and Shaefer as applied to claim 7 above, and further in view of Koss (US 2002/0112037).

Cantwell, Minolta, Williams, Hui, and Shaefer teach all the limitations of claim 5 except that the peripheral is a plotter.

The general concept of having a plotter on a network is well known in the art as taught by Koss. [0004]

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cantwell, Minolta, and Shaefer with the general concept of having a plotter on a network as taught by Koss in order to allow plotters to also to distribute their drivers as do printers.

Response to Arguments

13.   Applicant's arguments filed 9/15/2008 have been fully considered but they are not persuasive.

14.   First, the Examiner notes that the previous rejection under 35 U.S.C. 112 1st paragraph has been removed, but a new rejection under that statute has been applied based upon Applicant's amendments.

15.   Applicant argues that Cantwell does not use an embedded web server in the peripheral device to access the URL with the drivers automatically and without user intervention.

16.   First, the Examiner notes that automating a previously manual process is obvious under 35 U.S.C. 103(a), and that if this difference were actual, it would not be a patentable distinction. Secondly, using the Examiner's interpretation of the claims as stated in the 35 U.S.C. 112 2nd paragraph rejection above, Cantrell does have a web

server that provides the URL to a user (i.e. allows the PC to access the URL)
automatically and without user interaction.

17.   In response to applicant's argument that the examiner has combined an
excessive number of references, reliance on a large number of references in a rejection
does not, without more, weigh against the obviousness of the claimed invention. See *In
re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

18.   The Examiner further notes that motivation has been provided for the
combination of references in the 35 U.S.C. 103(a) rejections above.

19.   In response to applicant's argument that the examiner's conclusion of
obviousness is based upon improper hindsight reasoning, it must be recognized that
any judgment on obviousness is in a sense necessarily a reconstruction based upon
hindsight reasoning. But so long as it takes into account only knowledge which was
within the level of ordinary skill at the time the claimed invention was made, and does
not include knowledge gleaned only from the applicant's disclosure, such a
reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA
1971).

Conclusion

20.   The prior art made of record and not relied upon is considered pertinent to
applicant's disclosure. The Examiner cites these further references as evidence that
providing a URL to a personal computer from a peripheral to download and install
device drivers is well known in the art.

US 6678750, see Col. 11 "In an embodiment of the present invention, an address of the location e.g. the URL of a web site where the latest version of the device drivers may be downloaded and provided to the host computer..."

US 2002/0161939, see abstract "The present invention relates to a method of installing a device driver capable of driving a peripheral device installed in a slot of a PC after receiving the device driver from a server located in a global network." See also Fig. 3b, steps S25, 26, 27, and 24. See also Fig. 5, steps s40-s42 and s35-s38.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL E. KEEFER whose telephone number is (571)270-1591. The examiner can normally be reached on Monday through Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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MEK 11/18/2008

/Joseph E. Avellino/

Primary Examiner, Art Unit 2446